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AF
PATENT APPLICATION

ATTORNEY DOCKET NO. TRMB-1412

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Dennis YORK

Confirmation No.: 9289

Application No.: 10/651,586

Examiner: Tammara R. Peyton

Filing Date: 08/29/2003

Group Art Unit: 2182

Title: PORTABLE ELECTRONIC INSTRUMENT WITH FIELD-REPLACEABLE BATTERY/ INPUT/ OUTPUT MODULE

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 11/26/2007.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,
Dennis YORK

By

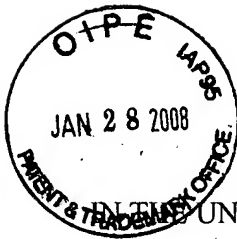
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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: York, Dennis

Patent Application

Serial No.: 10/651,586

Group Art Unit: 2182

Filed: August 29, 2003

Examiner: Peyton, T.

For: Portable Electronic Instrument With Field-Replaceable Battery/Input/Output Module

Reply Brief

In response to the Examiner's Answer mailed on November 26, 2007, Appellant respectfully submits the following remarks.

REMARKS

Appellant is submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellant is addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellant agrees with the other arguments presented in the Examiner's Answer.

Appellants Response to Examiner's Response to Argument (10)

I.

On page 9 at lines 17-20 of the Examiner's response section, while purporting to discuss a motivation for obviousness, the Response states "[F]urther, one of ordinary skill would readily recognize that the PDA's overall housing would be tailored to specific dimensions-therein the PDA must have mechanical retention features" in order for Dickie's PDA to securely fit and be retained in a housing of the portable computer." (emphasis original)

However, Appellant respectfully disagrees. That is, Appellant has reviewed Dickie and does not understand Dickie to teach or render obvious the requirement for a PDA that must have mechanical retention features" (emphasis added).

In contrast, Appellant respectfully submits that the teachings of Dickie, e.g., using a portable computer 104 as a dock for a PDA 102 would appear to provide that Dickie is not limited to a specific type and design of PDA 102 that must have mechanical retention features for use with the docking station (portable computer 104). Instead, Appellant respectfully submits that a more proper assumption would be that the dock of Dickie would have the retention features thereby allowing a plurality of different PDA designs to be utilized therewith.

In view of the above remarks and for reasons previously presented in the Appeal Brief, Appellant continues to assert that the present Claims are not taught or rendered obvious over Dickie and that the rejection of Claims 1-30 should be reversed.

II.

On page 10 at approximately lines 21, the Response states, “[N]o wherein in claims 1 and 15 does it convey that the processing unit (PDA) lacks an internal battery, therein...”.

Appellant respectfully disagrees with the Examiner’s characterization. Specifically Appellant points out that Claims 1 and 15 do not include the term PDA. Claim 1 features a “processing unit for an electronic instrument” and Claim 15 features a “portable electronic instrument”. As such, Appellant respectfully submits that there is no feature of a PDA in Claims 1 and 15.

Further, Appellant respectfully points out Claims 1-30 are quite clear on the features including the battery/input/output module and its distinction from the processing unit of the electronic instrument. Further, Appellant submits that the Specification, the Figures and the Claim language utilize the terms “processing unit” and “battery/input/output module” in alignment with their plain meaning and as one of ordinary skill in the art would read them. As such, Appellant respectfully submits the “processing unit” and “battery/input/output module” words of the Claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).

As such, Appellant respectfully submits that based on the plain meaning of the terms “processing unit” and “battery/input/output module” it is apparent that the “battery/input/output module” is not a charger or dock to provide a charge to the internal battery of the processing

unit as suggested by the present Response, but is clearly shown, described and claimed, as the “battery/input/output module” for the “processing unit” (emphasis added).

In view of the above remarks and for reasons previously presented in the Appeal Brief, Appellant continues to assert that the present Claims are not taught or rendered obvious over Dickie and that the rejection of Claims 1-30 should be reversed.

III.

On page 10 at approximately lines 24-27, the Response states, “[E]xaminer does not understand how the battery/input/output module would charge the portable device of Appellant if the portable device of Appellant does not already include a type of internal battery.”

Appellant respectfully points out that there are no Claimed features that state “the battery/input/output module would charge the portable device.” Instead, Claims 13-14 clearly provide the battery/input/output module charging features.

Further, Appellant respectfully points out that there are no Claimed features that include type of internal battery. Instead, the claims are clearly directed toward “processing unit” and the “battery/input/output module.”

As such, and in view of the above remarks and for reasons previously presented in the Appeal Brief, Appellant continues to assert that the present Claims are not taught or rendered obvious over Dickie and that the rejection of Claims 1-30 should be reversed.

IV.

On page 14 at item E), the Response provides a first rejection of Claims 10-12. Appellant has reviewed the new rejection and submits that Appellants respectfully submit that

the Examiner has provided an assessment of basic knowledge and common sense that is not based on any evidence in the record and as such, lacks substantial evidence support.

The “assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (MPEP 2144.03(A); *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). In particular, “[i]f such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge” (MPEP 2144.03(B); see *In re Soli*, 317 F.2d 941, 946, 37 USPQ 797, 801 (CCPA 1963); see also *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943)).

Furthermore, Appellant respectfully asserts “It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based” (emphasis added; MPEP 2144.03(E); See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970)).

Thus, Appellant respectfully submits that the basis for knowledge in the art as relied on by the Examiner is not set forth explicitly, as required. Appellant respectfully submits that the Examiner has not stated why the teachings are common knowledge. As such, Appellant respectfully asserts that the Examiner has not provided a clear and unmistakable technical line of reasoning, as required for the rejection of Claims 10-12.

Accordingly, Appellants respectfully that the Examiner provide adequate evidence in the form of an affidavit in support of the finding.


CONCLUSION

Appellant continues to assert that Dickie does not teach, describe, or suggest the claimed embodiments, for reasons presented above and for reasons previously presented in the Appeal Brief.

Respectfully submitted,

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Dated: 01.23, 2008



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